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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/927,176	08/10/2001	Scott K. Strenk	1120-004	4641

7590 04/02/2003

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EXAMINER
MAI, HUY KIM

ART UNIT	PAPER NUMBER
2873	

DATE MAILED: 04/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/927,176	STRENK, SCOTT K.
	Examiner	Art Unit
	Huy K. Mai	2873

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *21 January 2003* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *2-18* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *2-18* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *10&11* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

Regarding claims 3, earpieces covering the distal portion of the temples are well known in the art to provide a comfort to the ears of the user. Therefore, these limitations are unpatentable over the Zelman in view of Mauch's device.

Regarding claim 7, since one material has properties better than another material, it would have been obvious to a worker having general skill in this art to select a known material on the basis of its suitability for intended used as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

4. Claims 10-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee et al.

Lee et al discloses in Figs. 1-7, column 4-5, a device for coupling spectacles and clip-on sunglasses wherein the recessed socket (200,300) is made of a soft magnetic material such as iron-based metal, nickel-based metal or stainless steel. He also suggests in column 5, lines 44-46, column 7, lines 8-10 the recessed socket 30 and the magnet inserting member 301 can be substituted with each other. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the Lee et al device by providing the arm of the auxiliary spectacles with recessed socket as suggested by Lee et al to obtain the same device as claimed by the applicant in claims 10-17.

Response to Arguments

5. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the

applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

The applicant cites the case law *Smithkline Diagnostics, Inc. v. Helena Lab. Corp.*, 859 F.2d 878, 886-87 (Fed. Cir. 1988) for the reasons "This burden of obviousness has not been met with regard to claims 1-18". The applicant, however, fails to point out which burden of obviousness has not been met and provide the reasons why "This burden of obviousness has not been met" in view of the cited case law. Simply state "This burden of obviousness has not been met with regard to claims 1-18" in his argument without providing support what is not been met render such an argument is vague.

The applicant also cites the case law *In re Fritch,* 23 USPQ2d 1780, 1784 (Fed. Cir. 1992) for the reason "Teachings of references can be combined only if there is some suggestion or motivation to do so". That is exactly the examiner do in the rejection. The applicant does not point out and explain the reasons why the examiner's motivation in the rejection does not satisfy with the mentioned case law. In fact, both Zelman and Mauch teach the extends of the magnet constructed and arranged to fit into the recess of the socket is nothing more than a catch-and-click mating arrangement as argued by the applicant. In another word, the extends of the magnet constructed and arranged to fit into the recess of the socket taught by both Zelman and Mauch is a very strong motivation in the rejection in view of *In re Fritch,* 23 USPQ2d 1780, 1784 (Fed. Cir. 1992).

The applicant argues, in page 4, lines 13-14, that "one of the features recited in independent claim 9 is the "catch-and-click mating arrangement" feature" and concludes that Zelman teach away from his claimed invention. The applicant is incorrect in statement "the "catch-and-click

mating arrangement" feature". Catch-and-click mating is not a feature, but the function of the extends of the magnet constructed and arranged to fit into the recess of the socket as disclosed by the applicant as well as Zelman and Mauch. The applicant does not point out the reasons why the extends of the magnet constructed and arranged to fit into the recess of the socket in the Zelman and Mauch references do not have the function of catching and clicking as argued by the applicant. Therefore, the applicant's conclusion "Zelman teach away from his claimed invention" does not have a merit in traverse the rejection.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Huy K. Mai whose telephone number is (703) 308-4874. The examiner can normally be reached on M-F (8:00 a.m.-4:30 p.m.).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Georgia Y. Epps can be reached on (703) 308-4883. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703) 308-7724 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

Huy Mai
Primary Examiner

HKM/
March 31, 2003